

REMARKS

Claims 1-44 were presented for examination. Claims 1-44 were rejected. Specifically, Claim 42 was rejected under 35 U.S.C. §112, second paragraph. Claims 1-35 were rejected under 35 U.S.C. §102(e) as anticipated by, or in the alternative under 35 U.S.C. §103(a), as obvious over Mitra et al. (US Patent No. 6,673,761). Claims 1-35 were rejected under 35 U.S.C. §102(e) as anticipated by, or in the alternative under 35 U.S.C. §103(a), as obvious over Ouellette et al. (US 2004/0244132). Claims 1-3, 5-7, 10-18 and 20-22 were rejected under 35 U.S.C. §102(e) as anticipated by, or in the alternative under 35 U.S.C. §103(a), as obvious over Bragulla (WO 2004/024857). Claims 36-44 were rejected under 35 U.S.C. §103(a), as unpatentable over Mitra et al. (US Patent No. 6,673,761). Claims 36-44 were rejected under 35 U.S.C. §103(a), as unpatentable over Ouellette et al. (US 2004/0244132).

CLAIM REJECTIONS

A. Turning now to the claim rejection under 35 U.S.C. §112, second paragraph, independent claim 42 has been amended to include the limitation "more than about 0 wt. %" for each of the recited ranges. Support for the amendment is found throughout the Specification, particularly beginning at page 5 [0020] and is understood by those skilled in the art. Therefore, Applicants respectfully request removal of the rejection of claim 42 under 35 USC 112, second paragraph.

B. Turning now to the rejection of claims 1-35 as being anticipated by Mitra et al., Applicants respectfully traverse the rejection. Mitra et al. is directed to a disinfecting cleaning wipe comprising a biocide and a biocide release agent to increase the amount of biocide released from the cleaning wipe onto the surface to be disinfected. [T]he biocide release agent is a cationic compound designed to compete with the cationic for the anionic species sites on the cleaning wipe thereby causing increased biocide release during use of the cleaning wipe. (Mitra, col. 5, line 66 to col.6 line 32).

In contrast, the presently claimed formulation is directed to a cleansing formulation comprising a brake dust barrier composition in sufficient amount to provide brake dust efficacy and substantially prevent at least one of build-up and adherence of brake dust on a surface.

To establish anticipation there must be no difference between the claimed invention and the disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scrappys Clinic & Res. Found. V. Genetech Inc.*, 18 U.S.P.Q.2d 1671 (Fed. Cir.1994). While the prior art reference need not use identical terminology, the reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir.1992).

Applicants respectfully assert that the disclosure in Mitra et al. fails to anticipate claims 1-35 because nothing in Mitra et al. fails to teach or disclose a brake dust barrier composition as presently claimed. Therefore, Mitra et al. cannot anticipate the invention as claimed and the rejection should be removed.

Claims 1-35 were rejected in the alternative as being obvious over obvious over Mitra et al. Applicants respectfully traverse the rejection. In addition, Claims 36-45 were also rejected as being unpatentable as being obvious and over Mitra et al.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir.1996).

Absent in Mitra is any suggestion or motivation to modify the disinfectant wipe in Mitra to achieve the cleaning formulation comprising brake dust barrier composition as claimed. As discussed herein, Mitra is directed to a disinfecting cleaning wipe having improved biocide release. The compositions disclosed in Mitra comprise a cationic biocide and a biocide release. There is no disclosure or suggestion in Mitra to any automotive applications, never mind a brake dust barrier composition. One skilled in the art would not be motivated by the teachings of Mitra to develop an automotive cleaning formulation having brake dust barrier efficacy as claimed.

Therefore, the present claims 1-44 are non-obvious over Mitra et al. and applicants respectfully request removal of the rejection of claims 1-44.

C. Turning now to Ouellette et al., claims 1-35 stand rejected as anticipated by, or in the alternative, obvious over Ouellette et al. Applicants traverse this rejection.

A compound or composition of matter is anticipated if the disclosure in a single reference places that compound or composition in possession of the public. See *In re Brown*, 329 F.2d at 1011, 141 U.S.P.Q. at 249. The reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures" *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). The reference must therefore provide a certain degree of precision with respect to the specific compound claimed.

For example, in *Ex parte Westphal*, 223 U.S.P.Q. 630 (Bd. Pat. App. 1983), the claim was directed to a composition containing 3-methylthio-4-amino-6-tert-butyl-1,2,4-triazine-5-one. The examiner rejected the claim under § 102 as anticipated by, *inter alia*, a patent to Fawzi. This patent disclosed a compound substituted at a particular position with alkyl having 1 to 8 carbon atoms, but did not specifically name the claimed tert-butyl radical. Thus, the Board found that the Fawzi patent did not provide the precision necessary for anticipation under § 102. *Ex parte Westphal*, 223 U.S.P.Q. at 631.

Similarly, in *Arkley*, the court found that the single claimed compound was not described in the prior art within the meaning of § 102. The prior art generically disclosed a class of compounds encompassing the claimed compound, as well as over 230,000 other compounds. The Board contended, however, that the prior art contained two examples that disclosed the exact precursors of the claimed compound.

The court found that these examples disclosed exact precursors only to the extent that one selects the correct acid to react with a particular tertiary amine, which also must be selected. *In re Arkley*, 455 F.2d at 588, 172 U.S.P.Q. at 526. The court further found that there was nothing in the reference that “‘clearly and unequivocally’ directs those skilled in the art to make this selection . . .” *Id.* Thus, the court reversed the rejection under § 102.

Ouellette et al. is directed to a disposable cleaning mitt for use in cleaning a variety of surfaces including automotive interior and exteriors. (Ouellette, p.1, [0001]) However, nothing in Ouellette clearly and unequivocally’ directs those skilled in the art to make the selection of components disclosed in Ouellette to provide a cleaning composition having brake dust barrier composition for brake dust efficacy as claimed. Therefore, Ouellette cannot anticipate the claims, and Applicants respectfully request removal of the rejection.

In addition, applicants respectfully traverse the rejection of claims 1-44 under 35 USC § 103 over Ouellette et al.

Our case law makes clear that one cannot base obviousness on what one might try or find obvious to try. Rather the proper test requires what the prior art would have led one skilled in the art to do. Moreover, where the prior art has not recognized the “result-effective capability of a particular invention parameter, no expectation can exist that optimizing the parameter would successfully yield the desired improvement. *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977)

The present claims recite a brake dust barrier composition in sufficient amount to provide brake dust efficacy. The brake dust composition disclosed may comprise at least one film forming compounds having antistatic properties, fluorinated compounds and mixtures thereof, the film forming compounds being selected from the group comprising sulfonated styrene/maleic anhydride copolymers, sulfonated polystyrenes, linear silicone/ethylene oxide copolymers, modified polycarboxylate copolymers, acrylic polymers, silicone/acrylate copolymers, and mixtures thereof.

There is nothing in Oullette et al. that discloses or teaches a brake dust barrier composition to provide brake dust efficacy, nor any of the components or parameters which will effectively result in brake dust barrier efficacy. At best, Oullette et al. provides no more than an "obvious to experiment" without any reasonable expectation of success, which is not the legal standard for an obviousness rejection.

Therefore, the present claims 1-44 are non-obvious over Oullette et al. Applicants respectfully request removal of the rejection of claims 1-44.

D. Claims 1-3, 5-7, 10-18 and 20-22 also stand rejected as being anticipated, or in the alternative, obvious over Bragulla.

As presented, the claims recite a brake dust barrier composition in sufficient amount to provide brake dust efficacy. The brake dust composition may comprise at least one film forming compounds having antistatic properties, fluorinated compounds and mixtures thereof, the film forming compounds being selected from the group comprising sulfonated styrene/maleic anhydride copolymers, sulfonated polystyrenes, linear silicone/ethylene oxide copolymers, modified polycarboxylate copolymers, acrylic polymers, silicone/acrylate copolymers, and mixtures thereof.

Nothing in Bragulla sufficiently describes the claimed invention to place the claimed invention in the possession of the public and one of ordinary skill in the field would clearly

distinguish between the claimed invention and the disclosure of Bragulla. Therefore, Bragulla cannot anticipate the present claims.

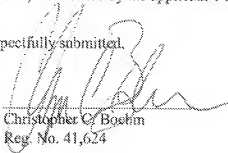
Moreover, Bragulla, at best, offers no more than an invitation to experiment or to try and of a variety of parameters and components. Nothing in Bragulla teaches or suggests the combination of components claimed to achieve brake dust efficacy. Therefore, the present claims are not obvious over Bragulla. Applicant respectfully requests removal of the rejection and allowance of the claims.

In view of the above amendments and the discussion relating thereto, it is respectfully submitted that the present application is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130, maintained by the applicant's attorney.

Respectfully submitted,

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